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10/524,113

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EXAMINER

SHAPIRO, JEFFERY A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,113	Applicant(s) HURWITZ ET AL.	
	Examiner JEFFREY A. SHAPIRO	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/25/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a wherein clause in the last three lines. It is unclear since some of the members of the group are either redundant or at odds with each other. For example, the term "retail store" can include one or more of a single store. This is considered to include multiple stores. Maybe it was intended to include multiple groups of stores?

3. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, MPEP, section 2173.05(p) states, "[a] single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." *Id.* Claims 16-18 recite the apparatus and system. Claim 16 and its dependents recite the apparatus of a machine readable

Art Unit: 3653

storage medium that provides instructions executed from a processor. Claim 16 and its dependents also recite method steps of initiating a payment media acceptance operation, automatically determining suitability, and processing the payment media found to be unsuitable. Since Claim 16 and its dependents claim both an apparatus and the method of using an apparatus, these claims are indefinite.

Claim Rejections - 35 USC § 101

Claims 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, Claims 16-18 are directed towards neither a “process” nor a “machine,” but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP, section 2173.05(p).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402).

Regarding Claims 1, 16 and 19, Dobbins discloses the method and system of electronically managing a payment media exception processed from a payment media originating source, i.e., such as a cashier's cash drawer as mentioned at paragraph 3,

first five lines, by a payment media handling apparatus, such as a bill acceptor (106), as mentioned in paragraph 32.

Dobbins further discloses Initiating a payment media acceptance operation using the payment media handling apparatus, i.e., such as mentioned in paragraphs 32 and 36, which mentions that cashiers who identify themselves or other persons with wireless ID tags, such as the store manager, may access the payment media handling apparatus.

Dobbins further discloses processing the at least one of the payment media determined to be unacceptable based upon instructions provided by a retail store. See Dobbins at paragraph 49, last four lines, i.e., “many retailers require all \$50 and \$100 bills be dropped directly and immediately into the electronic safe...”

Regarding Claims 2, 17 and 20, note that the originating source is the cash till of a register from a retail store.

Regarding Claims 3 and 18, note that Dobbins disclose handling bills and checks at paragraph 49.

Regarding Claim 4, note that Dobbins discloses reporting various parameters and data regarding the transactions with the payment media handling device at figure 4 and at paragraph 5, for example.

Regarding Claim 5, Dobbins discloses damaged or worn bills at paragraph 29.

Regarding Claims 1, 16 and 19, Dobbins does not expressly disclose, but Jones discloses automatically determining if the payment media is in an acceptable or unacceptable condition. See Jones at col. 8, lines 35-53.

Regarding Claims 1, 16 and 19, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have included a currency or bill acceptor as taught by Jones, in Dobbins' currency acceptor, since Dobbins' does not disclose details of such an acceptor, but suggests the use of an acceptor as taught by Jones. Further, Jones' device is disclosed at col. 3, lines 12-20 as rapidly processing bills. Thus, it would have been evident to one ordinarily skilled to incorporate Jones' bill acceptor into Dobbins' apparatus in order to rapidly process bills.

Regarding Claims 6-7, Jones further discloses notifying the user that the at least one payment media has been rejected by the currency handling device. See Jones at col. 8, lines 35-53, in which rejected bills are returned to the customer/user. Note that the act of returning the bills to the customer is construed as notification that the bills are unacceptable.

Regarding Claim 9, note that both Jones' and Dobbins currency handling devices are considered to be secure drop boxes.

Regarding Claim 10, note that Dobbins discloses placing payment media in an envelope at figure 2, for example.

Regarding Claims 11 and 12, Dobbins discloses providing information concerning the envelope of currency at paragraph 33.

Regarding Claim 13, see Dobbins again at paragraph 49, last four lines.

Regarding Claim 14, note again that Dobbins discloses processing envelopes only from approved users with a user id such as a wireless device as described at paragraph 35 and processing only particular values of bills at paragraph 49.

Regarding Claim 15, Dobbins discloses notifying a supervisor at paragraphs 36, 38 and 44-46.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402) and further in view of Jones (US 6,363,164 B1).

Dobbins discloses the system described above.

Regarding Claim 8, Dobbins does not expressly disclose, but Jones '164 discloses instructing the user to manually rearrange or reposition a portion of the currency that is determined to be unacceptable by the media handling apparatus, for the purpose of having the operator turn over reverse-faced bills that were unidentified and put them through the banknote validator a second time. See Jones at col. 63, lines 45-62 and col. 64, lines 55-63.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have instructed the user of Dobbins' currency acceptor to manually turn over reverse-faced bills and re-feed them through the bill validator, as taught by Jones, in Dobbins' currency acceptor, for the purpose of validating all bills in a stack, including those that are reverse-faced.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 3653

unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-20 of copending Application No. 10/524,109; Claims 1-19 and 21 of copending Application No. 10/524,110; Claims 1-19 and 24 of copending Application No. 10/524,111; Claims 1-18, 23 and 35 of copending Application No. 10/524,112; Claims 1-7, 9-10 and 12-14 of copending Application No. 10/933,289; and Claims 1-9, 11, 13-33, 35 and 37-45 of copending Application No. 11/117,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of each of the mentioned applications embodies the subject matter of the Claims of the instant application. Specifically, these Claims recite a method of electronically managing a payment media exception processed from a payment media originating source by a payment media handling apparatus including the steps of initiating payment

media acceptance using the payment media handling apparatus, automatically determining whether at least one of the payment media is in an unsuitable condition to be accepted by the media handling apparatus, and processing the at least one of the payment media determined to be unsuitable based on rules in a lookup table, instructions from a user, instructions from a supervisor and instructions provided by an entity other than a retail store.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments filed 9/25/08 have been fully considered but they are not persuasive. Applicant's Independent Claim 1 is reproduced below as representative of the independent claims.

1. (Original) A method of electronically managing a payment media exception processed from a payment media originating source by a payment media handling apparatus, the method comprising:
initiating a payment media acceptance operation using the payment media handling apparatus;
automatically determining whether at least one of the payment media is in a condition unsuitable to be accepted by the payment media handling apparatus; and
processing the at least one of the payment media determined to be unsuitable based on at least one of a group of rules stored in a lookup table, instructions provided by an user initiating the payment media acceptance operation, instructions provided by a supervisor in a retail store and instructions provided by an entity other than a retail store, wherein a

retail store includes one or more of at least a single store, multiple stores, one or more third party concession stands located within a single store and two or more stores located within a mall.

Dobbins discloses a device in the form of a drop safe that processes payment media in various forms. Dobbins discloses accessing the payment media apparatus to initiate an acceptance operation at paragraph 32 by a cashier.

Paragraphs 32 and 36 state as follows.

[0032] FIG. 2 illustrates an envelope 200 suitable for use in the present invention. The envelope is designed to be approximately the size of a standard currency bill so that the envelope 200 will fit through the entry slot and cassette of a bill acceptor of an electronic safe. As discussed above, an unreadable currency bill, a check or other item may be inserted into the envelope. When a cashier identifies himself or herself to the electronic safe interface module, the controller enables the bill acceptor to expect the envelope and its contents to be deposited. The cashier may enter the value of money to be deposited through a keypad, upon which the controller will allow the cashier to enter whether the value entered is for a rejected bill, a check, a coupon or some other paper item to be deposited. The controller will then enable the bill acceptor to accept the envelope 200. The bill acceptor will accept any paper without attempting to read its value. In one aspect of the present invention, the value of the media contained in the envelope is transferred to the electronic safe directly from a point of sale terminal connected to the electronic safe.

[0036] Persons other than cashiers can be provided with wireless ID tags. For example, the store manager or other authorized personnel can use a wireless ID tag to trigger reports, act as an electronic key similarly to the memory modules described above, or otherwise interact with the electronic safe. Third party collectors can similarly have a wireless ID tag to replace the need for a special key, memory module, or keying in an ID on a keypad at the time a collection is made. The use of keypads to enter the ID of managers, and third party collectors represents a significant security risk as the watchful eyes of unauthorized people could allow improper access to the secure information or the "combination" to the safe. All the technology available to memory keys including changing the ID day to day, restricting use by time of day, making obsolete the ID of personnel who have left the company, and the use of various

encryption algorithms to prevent the electronic decoding of codes can be used on wireless ID keys in accordance with the present invention.

As can be seen, the cashier is placing an envelope with payment media that fits within the entry slot of a bill acceptor in an electronic drop safe.

Dobbins does not expressly discuss the details of the bill acceptor operation, but Jones '402 discusses the operation of a bill acceptor at col. 3, lines 12-20, which automatically determines suitability or unsuitability. Note that the terms "suitable" and "unsuitable" are relative terms in that the rules required to be used by Applicant's claim language can include any criteria used to reject or accept a particular payment media. In the case of Jones, the criteria on which suitability is based upon comparison with image patterns as illustrated at figures 17a-17c, elements (128b, 142). Figure 50a illustrates the criteria of length and width, element (1104), color (1112) and pattern as illustrated in figure 50b, element (1122). Other criteria includes good call (1333), figure 55 and no call bills (1334), figure 55.

Applicant's claim 1 only requires that the rules/instructions for acceptance/suitability be entered by a user or a manager. There is no limitation on when the user or manager enters the rules or how this is done. The criteria taught by Jones '402 are software based and entered into a controller memory by an individual. In order to meet the claim limitations of Applicant's independent claims, all that has to happen is the individual who enters the criteria later becomes the user or manager of the retail establishment.

The retail establishment can be either a single store or a single kiosk. Since Dobbins' device can be construed as a stand-alone kiosk, Applicant's independent claims are considered to read on Dobbins' apparatus.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/
Examiner, Art Unit 3653

January 4, 2009